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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,434	03/12/2004	Isabelle Bara	5725.0362-01	5266

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

MAIL DATE	DELIVERY MODE
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/798,434	Applicant(s) BARA ET AL.	
	Examiner Gina C. Yu	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-60,62,63 and 65-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-60,62,63 and 65-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/277,226.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/31/04, 9/24/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 37 recites general formulations for silicone resins, but does not define what R groups represent.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 3, 8, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Merat et al. (US 5126136).**

Merat discloses a process making a water-proof lotion by incorporating 2.5 % of dimethiconol poly[oxy(dimethylsilylene)], alpha-hydro-\_\_\_ hydroxy as a film former and water proofing compound in an water and oil emulsion. See Example 3. See also Examples 5 and 7.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3-19, 23-45, 48-52, 55-60, 62, 63, 67-69 are rejected under 35**

**U.S.C. 103(a) as being unpatentable over Nanba et al. (US 6063391) in view of Merat.**

Nanba teaches a method of making transfer-free lipstick composition by adding perfluoroalkyl denatured silicone, alkyl cyclopentasiloxane, and polyether denatured silicone in the oil phase. See instant claims 1, 12, 59. Polyether denatured silicone is KF 6008 from Shin-Etsu Chemical, which meets the oxyalkylenated silicone of the instant invention. Applicants disclose that KF 6008 is a substituted oxyalkylenated silicone which is useful for the present invention. Also used in the Nanba composition is dyestuffs (titanium dioxide and red pigments) and fillers and organic resins. See instant claims 15, 16, and 18. Pearl agent is taught in col. 6, lines 16, see instant claim 17. The reference teaches that lipstick compositions are also formulated in form of emulsions and illustrates in Example 17 a formulation comprising 5 % of water. See col. 6, lines 18 –24; col. 9, lines 49 – 60; instant claims 42, 43, 48. The volatile silicone oils of instant claims 23-27 are taught in col. 6, line 54 – col. 7, line 52. The non-silicone fatty substances of instant claims 39-40 are taught in col. 6, lines 8 – 13, and Example 16 uses solid paraffin. The reference further teaches adding organic/inorganic powders to the lipstick formulations, and illustrates in Example 18 a formulation comprising 5 %

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by weight of spherical silicone rubber powder. See instant claims 49-52. Although Nanba does not specifically teach non-spherical type or the size of filler, the reference generally teaches using organic or inorganic powders suitable for lipstick formulations, thus a skilled artisan would have While the reference does not specifically describe the average refractive index of the totality of the silicone oil, examiner views that Nanba meets the claimed limitation since the prior art uses the same types of oils and fillers in the weight amounts as claimed in the present application. See instant claims 55-57. The silicone resins of instant claim 38 is taught in col. 6, lines 25 – 37.

While Nanba uses the dimethiconol of the instant claims in making transfer-resistant make up compositions, the reference does not specifically teach using the dimethiconol to produce transfer-resistant effect.

Merat discloses a process making a water-proof lotion by incorporating 2.5 % of dimethiconol poly[oxy(dimethylsilylene)], alpha-hydro-omega- hydroxy as a film former and water proofing compound in an water and oil emulsion. See Example 3. See also Examples 5 and 7. See instant claim 58.

It would have been obvious to one of ordinary skill in the art at the time of the present invention that the addition of polyether silicone in the process of making transfer-free lipstick in Nanba obviously contributes to the staying power of the composition because Merat teaches that the polyether silicone functions as a film former and water proofing compound. Using the product of the combined references as intended would obvious reduce or eliminate the transfer or migrate of the cosmetics.

**Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nanba and Merat as applied to claims 1, 3-19, 23-45, 48-52, 55-60, 62, 63, 67-69 as above, and further in view of Cosmetics Additives (1991).**

The combined references fail to teach the dyes of instant claim 20.

Cosmetics Additives teaches quinolin yellow and tartrazine are commercially available colorants. See p. 70.

It would have been obvious to one of ordinary skill in the art to use commercially available dyestuff to conveniently make lipstick compositions of the combined references. No surprising or nonobviousness in using conventional dyestuff is seen, unless proven otherwise.

**Claims 1, 12, 46, 47, 49, 53, 54, 65, 66 are rejected over Arraudeau in view of Merat.**

Arraudeau teaches cosmetic composition comprising spherical or spheroidal particles having dimensions from 1-15 microns. See col. 3, lines 37 – 53. Powders of synthetic spheronized polymers and microspheres are taught. See col. 3, lines 45 – 65. The reference teaches adding colloids or film-forming polymers to "to favor the stability of the system or produce an additional film-forming effect". See col. 5, lines 56 – 65.

Merat discloses a process making a water-proof lotion by incorporating 2.5 % of dimethiconol poly[oxy(dimethylsilylene)], alpha-hydro-omega- hydroxy as a film former and water proofing compound in an water and oil emulsion. See Example 3. See also Examples 5 and 7. See instant claim 58.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the fluid cosmetic compositions of Arraudeau by incorporating dimethiconol of Merat, because the latter teaches that dimethiconol is a film former and water proofing compound used in water and oil emulsion. The skilled artisan would have been motivated to make a water-resistant cosmetic compositions and had a reasonable expectation of success in making a film-forming transfer-resistant cosmetics because Arraudeau teaches add conventional film-forming ingredients or colloids to produce stability of the system or film-forming effects.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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**Claims 1, 3, 45, 48-60, 62, 63, 65-69 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 7-69, 76, 77 of copending Application No. 10/366371.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to the use of cosmetic compositions comprising same oxyalkylenated silicone substituted at the alpha- and omega positions and additives which overlap. While the '371 invention is an anhydrous composition, the present inventions of the independent claims are not limited to any amount of water which would limit the invention to aqueous composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

Applicant's arguments filed on March 12, 2004 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone



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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Gina C. Yu  
Patent Examiner